

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Cade, Dominique :
Nicolas, et al
Examiner: Edmund H. Lee
APPLICATION NO.: 10/795898 :
Group Art Unit: 1732
FILING DATE: 03/08/2004 :
TITLE: APPARATUS FOR AND METHOD
OF SEALING CAPSULES

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PETITION FOR RECONSIDERATION OF PTA, 37 CFR 1.705(b)

Applicant submits this petition for reconsideration of patent term adjustment, being filed simultaneously with the payment of the issue fee.

Applicant respectfully requests reconsideration of patent term adjustment based on the holding in *Wyeth v Dudas*, 580 FSupp 138 (2008), because the patent did not issue within three years of the filing date, excluding time after filing the request for continued examination and “overlap” as clarified in *Wyeth* :

1. This is a request for reconsideration of the patent term adjustment (PTA) of 472 days indicated in the Determination of Patent Term Adjustment Under 35 USC § 154(b) that was attached to the Notice of Allowance re-mailed on June 19, 2009. Applicants respectfully request re-computation of the period of adjustment pursuant to 37 C.F.R. § 1.703(b).
2. The request is being filed simultaneously with the payment of the issue fee.
3. Applicants submit a Statement of Facts as required by 37 C.F.R. § 1.705(b)(2).
4. The fee set forth in § 1.18(e), as required by 37 C.F.R. § 1.705(b)(1), is paid as follows: please charge deposit account 16-1445 any necessary fees and credit any overpayments.

A. Statement of Facts Required by 37 C.F.R. § 1.705(b)(2)(i), (ii), (iii) and (iv)

Prosecution Delay:

Applicant does not challenge the PTA calculation based on the 14-4-4 Rule and extensions taken by Applicant during the prosecution of this matter. As indicated on the PTA tab in PAIR on the USPTO website, PTA should be 472 days based on those delays by the USPTO and Applicant, computed based on the following:

3/8/2004: Filing date

2/23/2007: First OA, 656 days later than 14 months after the date on which the application was filed under rule 1.702(a)(1).

5/23/2007: Response to First OA, 58 days later than the 3 month period of reply under rule 1.704(b).

8/2/2007: Response to non-Compliant Amendment, 13 days later than period for reply under rule 1.704(c)(7).

10/30/2007: Final Rejection in response to Applicant's 8/2/2007 filing, within the period of reply under rule 1.702(a)(2).

1/30/2008: RCE, 28 days after the 3 month period of reply under rule 1.704(b).

4/28/2008: Non-Final Rejection, within the period of reply under rule 1.702(a)(2).

10/29/2008: Response to Non-Final Rejection, 91 days later than the 3 month period of reply under rule 1.704(b).

3/6/2009: Final Rejection, 6 days later than the period of reply under rule 1.702(a)(2).

6/3/2009: Applicant's Amendment, within the period of reply under rule 1.704(b).

6/19/2009: Corrected Notice of Allowance, within the period of reply under rule 1.702(a)(2).

The delays from the PTO (662 days) minus the delays from Applicants (190 days) result in a PTA of 472 days.

3-year Delay for Issuance:

Applicants request inclusion of 357 additional days to PTA for failure to issue a patent within 3 years from filing. See *Wyeth, supra*; 35 USC 154(b)(1)(B); 37 CFR 1.702(b). These days are calculated as follows (37 CFR 1.703(b)):

3/8/2004: Filing date

3/9/2007: Day after 3 years from filing date.

2/29/2008: Day on which RCE filed.

357: Number of days from 3/9/2007 to 2/29/2008, inclusive.

B. 37 C.F.R. § 1.705(b)(2)(ii) - Relevant Dates as Specified in §§ 1.703(a) - (e) for Which an Adjustment is Sought and the Adjustment as Specified in § 1.703(f) to Which the Patent Is Entitled:

Applicants respectfully request re-computation of the period of adjustment of 472 days pursuant to 37 C.F.R. § 1.703(b). As the dates above indicate, there is no overlap for time to calculate the number of days of PTA for the 3-year delay and other delays by the USPTO. See *Wyeth, supra*. The 656-day delay under the 14-month rule is from 3/8/2004 to 2/23/2007. The time period on which the 3-year delay is based does not begin until 3/9/2007 and ends on 2/29/2008, the day on which a RCE was filed. The subsequent time is excluded. 37 CFR 1.703(b)(1). The next USPTO delay is from 10/29/2008 to 3/6/2009, during the excluded period. Therefore, Applicant should be given an additional 357 days for PTA due to the delay in issuing a patent within 3 years from the filing date. Applicants respectfully request a total PTA of 829 days (472 days plus 357 days).

C. 37 C.F.R. § 1.705(b)(2)(iii) - Is Patent Subject To a Terminal Disclaimer

The patent granted on this application is not subject to a terminal disclaimer.

D. 37 C.F.R. § 1.705(b)(2)(iv) - Circumstances During the Prosecution of This Application Constituting a Failure to Engage in Reasonable Efforts to Conclude Processing or Examination

The PTO calculation of the period of reduction of adjustment pursuant to 37 C.F.R. § 1.704, as shown by the PAIR PTA, and provided above, is 472 days. The calculation is discussed above, taking into account delays by Applicants.

Conclusion

Applicants submit that the Determination of PTA of 472 days that was attached to the Notice of Allowance re-mailed on June 19, 2009, is incorrect because it does not account for the issuance of the patent more than 3-years after the filing date. Accordingly, Applicants respectfully request re-computation of the period of adjustment pursuant to 37 C.F.R. § 1.703(b). Applicants respectfully request a PTA of 829 days. A fee is due with this request. Please charge any payment or credit any overpayment to Charge Account 16-1445.

Respectfully submitted,

/Mary J. Hosley/

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